

Appl. No. 10/750,016

Amendment dated March 7, 2005

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**Remarks**

Claims 1-20 are pending in the instant application. Claims 10-12 have been withdrawn from consideration. Nonetheless, Applicants request their reintroduction into prosecution upon allowance of a generic independent claim. Claims 15-20 have been withdrawn from consideration and canceled. Accordingly, Claims 1-9 and 13-14 form the subject matter of this response. Reconsideration of the present application in view of the amendments and the following remarks is respectfully requested.

**Restriction Requirement**

The claims are subject to a restriction requirements under 35 U.S.C. § 121. The Examiner indicated that the inventions of Groups I, II, and III are distinct. Applicants' attorney provisionally elected to prosecute the Group I claims, and that election is hereby confirmed. The claims directed to Groups II and III stand withdrawn.

**Election Requirement**

The claims are subject to a species election under 35 U.S.C. § 121. The Examiner indicated that the inventions drawn to engaging an elastic member by holding said elastic member on a pair of wheels with vacuum (Species A) and the inventions drawn to engaging an elastic member by holding said elastic member on a pair of wheels with a pair of transfer bands (Species B) are distinct. Presently, Applicants believe that claim 1 is generic. Applicants' attorney provisionally elected to prosecute Species A. That election is hereby confirmed and claims 10-12 have been withdrawn, but Applicants reserve the right to reintroduce claims 10-12 upon allowance of a generic claim.

**Rejections Under 35 U.S.C. §103(a)**

The combination of Jessup and Herrin do not disclose each and every element of the claimed invention and there is no motivation combine Jessup and Herrin as the Examiner suggests.

In the Office Action mailed December 6, 2004, the Examiner rejects claims 1 and 13 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,545,158 issued April 13, 1996, to Jessup. (hereinafter "Jessup") in view of U.S. Patent No. 5,308,345 issued May 3, 1994, to Herrin (hereinafter "Herrin"). This rejection is respectfully traversed.

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Jessup is directed to a disposable garment including a continuous, selectively elasticized band joined about an opening thereof (Col. 1, lines 8 – 10). Herrin is directed to a system and method for manufacturing disposable diapers with an elastic foam waistband (Col. 1, lines 8 – 10).

Claim 1 of the present invention is directed to a method for applying an elastic member to an article web. Claim 1 includes, *inter alia*, the step of "applying said elastic member to said article web...wherein said outboard portions of said elastic member extend beyond said article web side edges." Claim 13 depends from claim 1, and as such, also includes all of the elements of claim 1.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

The Examiner, on page 4-5 the Office Action mailed December 6, 2004, initially asserts that "Jessup further discloses that when said elastic member is applied to said absorbent web [28], the outboard portions of said elastic member extend beyond the edges 78 of said absorbent web." Further, while the Examiner acknowledges that Jessup fails to disclose a method for applying an elastic member as claimed in the instant invention, the Examiner asserts that "the use of the method taught by Herrin to produce the novel, zone-stretched product taught by Jessup would have been obvious to one of ordinary skill in the art." Applicants respectfully disagree with each of the Examiner's assertions.

In particular, the Examiner has provided no suggestion or motivation whatsoever for why one of skill in the art would elect to modify Jessup by applying a waistband member according to the teaching of Herrin. As set forth in MPEP § 2143.01, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Moreover, Applicants submit that one of ordinary skill in the art would not have been motivated to Modify Jessup with the teachings of Herrin. Applicants assert that a waistband applied by the teachings of Herrin would have a substantially uniform elongation along the entire waistband. For example, as can be seen in Fig. 6 of Herrin, the waistband is held in place along the side edges as it is stretched by the stretching rollers and as such, the entire waistband will be stretched in a substantially uniform manner. The waistband member of Jessup, however, is configured to provide "a continuous waistband with different elasticities (Col. 7, lines 14 – 16). Accordingly, the references teach away from the combinations suggested by the Examiner. Based on the above, Applicants assert that the Examiner is relying on impermissible hindsight and inappropriately using the instant invention as a template to pick and choose from the teachings in the art.

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Nonetheless, even if there was a suggestion or motivation for one of ordinary skill in the art to suggest or not modify Jessup with Herrin, at best one would arrive at the disposable garment disclosed in Jessup having a waistband as applied by Herrin; that is, the outboard portions of said elastic member would not extend beyond the article web side edges as set forth in claim 1 of the present invention. As such, does not teach or suggest each and every element of the claimed invention. While Applicants recognize that the Examiner asserts that "Jessup further discloses that when said elastic member is applied to said absorbent web [28], the outboard portions of said elastic member extend beyond the edges 78 of said absorbent web," Applicants submit this is an improper reading of Jessup. Specifically, Jessup does not teach applying the waistband 32 to the absorbent structure 28, but instead sets forth that the continuous waistband 32 (which includes waistband members 64 and 66) is joined to the waistborder 30 (comprising front and back waistborder sections 42 and 46) of the garment 10 (Col. 8, line 28 – 30). This is clearly illustrated in Fig. 5. Thus, while the waistband of Jessup may extend beyond the absorbent structure, Jessup does not disclose the waistband extending beyond the side edges (outer edges 50 and 58) of the article (the garment 10) of Jessup.

As a result, and for at least the above reasons, Applicants respectfully assert that the Examiner has not established a *Prima Facie* case of obviousness with respect to independent claim 1, and claim 1 is therefore patentable over Jessup in view of Herrin. Likewise, Applicants submit that claim 13, which depends from claim 1, is also similarly patentable over Jessup in view of Herrin.

In the Office Action mailed December 6, 2004, the Examiner rejects claims 2-9 as being unpatentable under 35 U.S.C. §103(a) over Herrin in view of Jessup and further in view of U.S. Patent No. 4,943,340 issued July 24, 1990 to Ujimoto et al. (hereinafter "Ujimoto"). Claims 2-9 all eventually depend from claim 1. As discussed above, the Examiner has failed to establish a *prima facie* case of obviousness over independent claim 1 in view of Jessup in combination with Herrin. Moreover, Ujimoto does not correct for the deficiencies of Herrin and Jessup. That is, Ujimoto does not teach or suggest applying an elastic member to an article web where the outboard portions of the elastic member extend beyond the article web side edges. Therefore, for at these reasons, claims 2-9 are also patentable over the combination of Herrin, Jessup and Ujimoto.

Moreover, with regard to claim 2 and claims 3-8, which all eventually depend from claim 2, the portions of Ujimoto that the Examiner asserts discloses forming a line of weakness do not make such a disclosure. Rather, Col. 2, lines 1-5 and Col. 2, lines 46-51 of Ujimoto only disclose cutting an elastic sheet or web. Thus, Applicants assert that the combination of Herrin, Jessup and Ujimoto also fail to teach or suggest the element of forming a line of weakness in the elastic material. Therefore, for at

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these additional reasons, claims 2-8 are patentable over the combination of Herring, Jessup and Ujimoto.

Further, and with respect to claim 5, the Examiner states on Page 7 of the Office Action dated December 6, 2004, that the "Examiner interprets registered to mean that the adhesive is applied to the elastic member without leaving any space between the leading edge and trailing edge of said elastic member." Nonetheless, Applicants assert that the meaning of the term "registered" as used in the instant application is clearly set forth in the specification, for example at Page 13, line 33 to Page 14, line 8. As such, Applicants assert that the Examiner's interpretation of "registered" as used in connection with claim 5 of the instant invention is incorrect and accordingly, the combination of Herrin, Jessup and Ujimoto fail to teach or suggest each and every element of claim 5.

Further, and with respect to claim 8, the Examiner states on Page 7 of the Office Action dated December 6, 2004, that Fig. 2 of Jessup discloses an elastic member including a trailing edge defining a "w" shape. Fig. 2 of Jessup illustrates a continuous waistband 32 that defines a linear trailing edge. Thus, Applicants respectfully request that the Examiner clarify this rejection of claim 8. If such clarification cannot be provided, Applicants request that claim 8 be passed to allowance.

In the Office Action mailed December 6, 2004, the Examiner rejects claim 14 as being unpatentable under 35 U.S.C. §103(a) over Jessup in view of Herrin and further in view of U.S. Patent No. 5,560,793 issued October 1 to Ruscher et al. (hereinafter "Ruscher"). Claim 14 depends from claim 1. As discussed above, the Examiner has failed to establish a *prima facie* case of obviousness over independent claim 1 in view of Jessup in combination with Herrin. Moreover, Ruscher fails to correct for the deficiencies of Herrin and Jessup. That is, Ruscher does not teach or suggest applying an elastic member to an article web where the outboard portions of the elastic member extend beyond the article web side edges. Therefore, for at these reasons, claim 14 is also patentable over the combination of Herrin, Jessup and Ruscher.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that claims 1-9 and 13-14 are not obvious and are therefore patentable the cited references whether considered alone or in combination.

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**Prior Art Made Of Record**

Applicant has reviewed the references cited by the Examiner but not relied upon in rejecting the claims. However, Applicant asserts such cited references fail to teach or suggest the inventions recited in the rejected claims. Accordingly, the pending claims are patentable over such references.

In conclusion, and in view of the amendments and remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable consideration and the timely allowance of pending claims 1-9 and 13-14. Further, since Applicants believe Claim 1 to be generic, Applicants request the reintroduction into prosecution and allowance of claims 10 -12. If any additional information is required, the Examiner is invited to contact the undersigned at (920) 721-3862.

The Commissioner is hereby authorized to charge any fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I, Barbara D. Miller, hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Facsimile Number 703-872-9306 on March 7, 2005.

By: 

Barbara D. Miller